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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,132	12/31/2003	Vincent K. Lee	3339/3	6851

7590

09/22/2005

DENNISON, SCHULTZ, DOUGHERTY & MACDONALD  
1727 KING STREET  
SUITE 105  
ALEXANDRIA, VA 22314

EXAMINER
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HINZE, LEO T

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/748,132

Applicant(s)

LEE, VINCENT K.

Examiner

Leo T. Hinze

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*pu*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Objections***

2. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form. Claim 6 contains the limitation "at least one float." This limitation is in claim 1 from which claim 6 ultimately depends.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yao, US 5,258,963 (Yao) in view of Tsai, US D455,658 (Tsai).

a. Regarding claim 1:

Yao teaches an ornament with a timekeeping device comprising: a timekeeper body (20, Fig. 1); and a main casing (10, Fig. 1), wherein: the main casing has a bottom (11, Fig. 1) and the bottom has a smooth curved surface (“curved base”, col. 2, l. 17); the main casing and the timekeeper body combined together to form the ornament with the timekeeping device, and a center of gravity located at a lower part of the ornament (the device stays “upright”, so given the circular shape of the casing, its center of gravity must be within the lower part of the device) with the timekeeping device, whereby the casing performs a rocking effect (“automatic rocking motion”, col. 1, ll. 34-35). Yao also teaches that an ornament (14, Fig. 1) adds beauty to the overall article and can help adjust the left and right position of the container (col. 3, ll. 3-6), and that the device is capable of “numerous modifications” while still remaining within the disclosed scope (col. 3, ll. 20-25).

Yao does not teach a liquid ornament casing, the liquid ornament casing being a sealed casing, and the liquid ornament casing comprises at least a liquid and at least one float.

Tsai teaches a fluid clock, including a liquid casing with a float in the shape of a ducky (Fig. 9).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Yao to replace the pictured ornament with a liquid casing

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containing a float as taught by Tsai, because a person having ordinary skill in the art would recognize that a liquid casing having a float in the shape of a ducky would also “add beauty to the overall article and help adjust the left and right position of the container” and may particularly appeal to consumers who love duckies, thereby increasing the commercial profitability of such a device.

b. Regarding claim 2, the combination of Yao and Tsai teaches all that is claimed as discussed in the rejection of claim 1 above. Further, after the combination, the timekeeper body 20 of Yao would necessarily be in the casing that is not the liquid casing, i.e. a “secondary” casing.

c. Regarding claims 3 and 4:

The combination of Yao and Tsai teaches all that is claimed as discussed in the rejection of claim 1 above. As combined, the relative positions of secondary casing and the liquid ornament casing are not explicitly specified, but Yao teaches that it is important for the center of gravity to be located such that the device remains upright, that the axis of gravity is along the centerline of the device (A, B, Fig. 4), and that the ornamental device assists in adjusting the left and right positions of the device, as well as the two axes of gravity (col. 3, ll. 3-6).

The combination of Yao and Tsai does not teach:

- Claim 3: wherein the secondary casing is located below the liquid ornament casing;
- Claim 4: wherein the secondary casing is located above the liquid ornament casing.

It has been held that mere rearrangement of parts is not sufficient to patentably distinguish an invention over the prior art. See MPEP § 2144.04 (VI). It has also been held that aesthetic design

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changes are not sufficient to patentably distinguish an invention over the prior art. See MPEP § 2144.04 (I).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to additionally modify Yao to arrange the ornamental liquid casing and the secondary casing such that the ornamental liquid casing is either above or below the secondary casing, because the purpose of the ornamental features of Yao is to add beauty and to help adjust the axes of gravity, and a person having ordinary skill in the art would be motivated to adjust the relative positions of the two casings to maximize either the beauty or the functionality (i.e. positions of the axes) of the device, or even to arrive at the best compromise between beauty and functionality.

d. Regarding claims 5, 7 and 8, the combination of Yao and Tsai teaches all that is claimed as discussed in the rejection of claims 1, 3 and 4 above. Yao also teaches wherein the bottom of the main casing comprises weight (items 40 and 14 in Fig. 1 are in the bottom of the main casing, and both items have a mass).

e. Regarding claim 6, the combination of Yao and Tsai teaches all that is claimed as discussed in the rejection of claim 3 above. The combination also teaches at least one float, as discussed in the rejection of claim 1 above.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

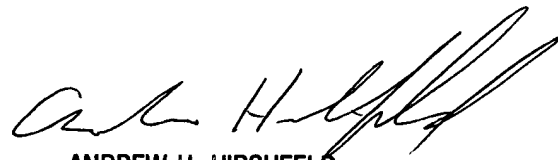
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo T. Hinze whose telephone number is (571) 272-2167. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Leo T. Hinze  
Patent Examiner  
AU 2854  
16 September 2005



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